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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,508	02/20/2001	Clemens Schmick	31512-168975	5369

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

10

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/785,508	Applicant(s) SCHMICK ET AL.	
	Examiner Carlos Lopez	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 12 and 14-21 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Amendment

The amendment filed on 9/4/02 has been entered as Paper No. 7. The amendment obviates the rejections made to claims 1-15, 19 and 20 made under 35 U.S.C 112. Additionally, previously indicated allowable subject matter of claims 4-5 and 16-18 is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3) Claims 1-3, 9, 10, 12, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Garthaffner et al (US 4,817,638). Garthaffner discloses a channel for moving smoking material 12. The channel being formed from elongated walls having endless flexible belt 23 and recessed conveyors 21. As for claim 20, conveyor 13 provides smoking material to the channel formed from belt 23 and recessed conveyor 22 (Figure 1). As for claim 12, the recessed conveyor 21 is coated with a current conducting material (Column 3, lines 29ff). As for claim 19, the recess of conveyor 21

are equidistant from each other (Figure 1). As for claims 9 and 21, the belt 23 and recessed conveyor 21 forming the channel move in a lengthwise direction.

4) Claims 1-5, 9, 16-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Korber (GB 919,150). Korber discloses a mechanism for handling tobacco stream wherein the sides or the bottom of a U shaped duct moves at the same speed as the stream of tobacco (Lines 40-47). As for claim 3, Korber in claim 10 provides for one or more conveyors belts which are inherently endless. As for claims 4-5, Korber discloses spikes 33 which would provide recesses. As for claim 17, Korber claim 10 provides for perforations at the base and side wall of the channel. As for claim 18, elements 2 and 31 of Korber provide housing for the walls of the conveyor belts. As for claim 20, Korber discloses that tobacco particles are supplied directly onto the conveyor means (Lines 8-19).

5) Claims 1-3, 9, 10 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dombek (US 6,390,099). Dombek discloses a channel for moving smoking material 4. The channel being formed from elongated walls having endless flexible belts 18 and 20 and recessed conveyors 12 and 24 serving as means for moving the elongated walls 18 and 20. As for claims 9 and 21, the belt 18 and 20 forming the channel move in a lengthwise direction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6) Claims 8, 14 and 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garthaffner et al (US 4,817,638). Garthaffner is silent disclosing the material forming the endless belt. However, Examiner takes Official Notice that belts are conventionally formed from polyurethane elastomers. It would have been obvious at the time the invention was made to one of ordinary skill in the art to have used a belt made from conventional materials since Examiner takes official notice that belts are made of polyurethane elastomers. Applicant is referred to US 3,592,334 where evidence supporting Examiner's Official Notice is disclosed.

As for claim 8, Garthaffner would be expected to have a drive means for the pulleys of belt 23 that forms the conveying channel.

As for claim 15, the distance between each recess is a multiple of the path of formed by Garthaffner's conveying channel.

Allowable Subject Matter

Claims 6-7, 11 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose or reasonably suggest having a pulley rotatable about a predetermined axis and including a cage having bars parallel with said axis and mating the teeth of the conveying belt, recited in claims 6-7. Similarly, the

cited prior art does not disclose or reasonably suggest a channel having two movable recessed stream contacting surface as recited in claim 11. Nor the prior art disclose having the conveying path width decrease in the direction of the lengthwise movement of the conveyor as recited in claim 13.

Response to Arguments

Applicant's arguments filed 9/04/02 have been fully considered but they are not persuasive.

In response to applicant's argument that the claimed apparatus transports "a stream of particulate material" or that the cited apparatus are not suitable for transporting particulate material, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the argued limitation in the preamble of claim 1 has not been given any patentable weight¹. Applicant argues that Grathaffner fails to provide conveyors moving in a lengthwise direction. It is held that conveyors 23 and 20 move in a lengthwise direction across the channel in order transport cigarettes from the channel inlet downstream to the channel outlet.


¹ If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

C.L
November 4, 2002